



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,510	08/16/2005	Antonio Lopez Munoz	5326-8	7871
23117 7590 11/12/2009 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER MCCLENDON, SANZA L				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
11/12/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/525,510

Applicant(s)

LOPEZ MUNOZ, ANTONIO

Examiner

Sanza L. McClendon

Art Unit

1796

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 October 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 2 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 10/27/2009. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 19-30.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☒ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Sanza L. McClendon/
Primary Examiner, Art Unit 1796

Continuation of 11, does NOT place the application in condition for allowance because: Applicant's arguments are not convincing. Applicant argues the primary reference sets forth that methods for producing inks are a "complex and unpredictable technology" and thus any modifications of the method and ink of Marshall may not lead to a viable ink composition—applicant refers the examiner to column 1, lines 13-14. The examiner disagrees. The examiner interprets the referenced teaching to defined the parameters of an ink composition, such as low viscosity, sufficient surface tension, and for continuous operation, sufficient conductivity, as well as, being a homogenous liquid. Applicant argues that Marshall et al is not directed to the inventive ink composition since the ink of Marshall et al comprises a polar conductive component, while the inventive ink does not. However as stated in previous arguments and rejections Marshall et al sets forth an embodiment in which no polar conductive component is required—see column 2, lines 21-28. Other differences argued by applicant included Marshall et al does not set forth the use of sublimatable coloring agents. This is not convincing since the claimed sublimatable coloring agent as written only has to be capable of being a sublimatable coloring agent, and additionally, the secondary reference to Codos et al is being relied on to show that it is known in the art of inkjet UV-curable ink compositions that sublimatable coloring agents are known additions to said ink compositions. Codos et al has not been relied upon for the method for producing ink compositions as argued by applicant. Marshall et al sets forth via example 2 an ink composition obtained by first dispersing a coloring agent into a monomer and prepolymer solution to obtain a pigmented dispersion, subsequently Marshall et al prepares a mixture by adding a photoinitiator to a mixture of monomers, which by teaching can obviously be substituted by an oligomer and monomer mixture (see column 5, lines 41 to column 6, line 2), and then adding said photoinitiator/reactive monomer/oligomer mixture into the pigmented dispersion, wherein said pigment dispersion has a particle size of no greater than 1 micron and the final mixture is then filtered to particles size of no greater than 1 micron in size. As stated in the previous office action the primary difference is Marshall et al adds the photoinitiator to the mixture prior to the addition of the pigmented mixture as in the instant claims. However, the courts have upheld selection of any order of mixing ingredients is prima facie obvious. The declaration under 37 CFR 1.132 is ineffective because it is not commensurate in scope with the claim, which is a method for producing an ink composition while the declaration is a printing method. Additionally, the declaration uses a "commercial ink composition" but fails to say how it compares the prior art applied ink, if it is the same prior art ink in the rejection, and fails to mention the steps set forth to produce the ink that was used in the testing/printing method as argued in the rejection. The declaration refers to dispersed dyes however it is not clear if the dispersed dye is the same as the sublimatable coloring agent in the claims and in the definition of the disclosure. Therefore it is deemed the instant rejection still stands.